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PROSKAUER ROSE LLP PATENT DEPARTMENT 1585 BROADWAY NEW YORK, NY 10036-8299			ART UNIT 3628	PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/696,693

Applicant(s)

FITZPATRICK ET AL.

Examiner

Siegfried E. Chencinski

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7 and 9-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7 and 9-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 30, 2006 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1 & 4-7 and 9-11 are rejected under 35 U.S.C. 103(a) as being disclosed by Clark et al.(US Patent 5,710,889, hereafter Clark) in view of Maggioncalda et al. (US Patent 5,918,217, hereafter Maggioncalda), Wolfberg et al. (US Patent 5,214,579, hereafter Wolfberg) and Earle (US Patent 5,262,942).

Re. Claim 1, Clark discloses an integrated system for providing financial services, comprising:

- at least one workstation having a central processing unit and a video display screen (Fig's 1 & 15; Col. 2, l. 36 – Col. 3, l. 34; Col. 26, l. 56 – Col. 27, l. 13);
- at least one host server (Fig's 1 & 15; Col. 2, l. 36 – Col. 3, l. 34; Col. 26, l. 56 – Col. 27, l. 13);;
- the at least one host server connected to the at least one workstation over a communication system for transmitting information between a workstation and at

Art Unit: 3628

least one host server (Fig's 1 & 15; Col. 2, l. 36 – Col. 3, l. 34; Col. 26, l. 56 – Col. 27, l. 13);

- an application interface operable on the workstation for accessing at least on a plurality of finance-related software applications comprising a real-time market data application (Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15); and
- a real-time investor monitoring system for monitoring investor mediated transactions (Real time - Col. 10, line 49; Col. 11, ll. 16-23), the system to provide timely proactive financial advice to investors (Clark's system is presented for the purpose providing financial services to customers, including financial advice).

Clark do not explicitly disclose the providing of all inclusive financial advice, such as financial planning advice. However, Maggioncalda disclose the providing of a financial planning application (Col. 2, line 33 – Col. 3, line 63; Col. 5, lines 32-33). Also, Clark do not explicitly disclose the provision of timely proactive transaction advice to the client. However, Wolfberg discloses providing timely proactive transaction advice to the client (Col. 24, ll. 43-52). Finally, Clark do not explicitly disclose enabling a user therewith to provide timely proactive transaction advice to the client user. However, Earle discloses the enabling of a user therewith to provide timely proactive transaction advice to the client user (Col. 7, ll. 48-59; Col. 9, ll. 54-57). It would have been obvious at the time of Applicant's invention to have combined the disclosures of Clark with those of Maggioncalda, Wolfberg and Earle for the purpose of a financial advisory system that focuses individuals on the financial decisions they must make today, recommends one or more specific financial products given these decisions, protects them from mistakes and, perhaps most importantly, provides an opportunity for their financial decisions to meet their investment goals for the future. The motivation for the practitioner at the time of Applicant's invention to invent such a system would have been to provide an investment management system which enables an investment client to achieve superior investment performance (Maggioncalda, Col. 1, ll. 54-55).

Re. Claim 4, Clark discloses an integrated system wherein the real-time market data application provides real-time market data comprising at least one of: quotes, news, and

Art Unit: 3628

historical and intraday charting (Col. 3, ll. 23-25; Col. 7, l. 28-31; Col. 10, line 49; Col. 11, line 18, a server is inherent).

Re. Claim 5, Clark discloses an integrated system wherein the real-time market data application provides a valuation ratings for at least one financial instrument (Col. 24, ll. 43-49).

Re. Claim 6, Clark discloses an integrated system wherein the application interface further includes a scratchpad application for moving information between applications (Inherent in MS Windows).

Re. Claim 7, Clark does not explicitly disclose an integrated system wherein the communication system connects a workstation to at least one host server via the Internet. However, Maggioncalda discloses an integrated system as recited by claim 1, wherein the communication system connects a workstation to at least one host server via the Internet (Col. 6, line 65).

It would have been obvious at the time of Applicant's invention to have combined the disclosures of Clark with those of Maggioncalda for the purpose of providing an integrated financial services system which can perform a number of different finance-related functions wherein the system connects a workstation to a host server via the internet.

Re. Claim 9, Clark discloses an integrated system further comprising an authentication system for determining user entitlements and accessing a user preference profile (Abstract; Col. 2, lines 48-50; Col. 5, line 63 – Col. 6, line 16; Col. 6, lines 36-47).

Re. Claim 10, Clark discloses an integrated system wherein the authentication system populates the application interface based on the user entitlements (Col. 5, lines 13-28; Col. 25, line 64 – Col. 26, line 6).

Re. Claim 11, Clark discloses an integrated system wherein the authentication system provides access to all applications using a single logon process (Col. 25, line 64 – Col. 26, line 24).

2. Claim 12 is rejected under 35 U.S.C. 103(a) as being disclosed by Clark in view of Wolfberg and Earle.

Art Unit: 3628

Re. Claim 12, Clark discloses a workstation for use in providing financial assistance to investors conducting investor mediated transactions over an online transaction system, the workstation comprising:

- a central processing unit (Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15);
- a video display screen (Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15);
- an application interface operable on the workstation for accessing at least one finance-related software application (Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15); and
- an investor monitoring system for monitoring investor mediated transactions conducted by the investor on the online transaction system, wherein the workstation is connected to at least one host server over a communication system which enables communication between the workstation and at least one host server, wherein the investor monitoring system monitors at least one investor account for at least one investor account mediated transaction and communicates to the financial advisor a communication regarding the at least one investor-mediated transactions on a real-time basis upon the at least one investor mediated transaction, the financial advisor therewith able to proactively intercede in the investor mediated transaction (Col. 5, line 63 – Col. 6, line 16; Col. 10, l. 49; Col. 11, ll.16-23; Col. 13, lines 63-64).

Clark does not explicitly disclose a financial advisor receiving a communication regarding an investor mediated transaction and the financial advisor proactively interceding in the investor mediated transaction. However, Wolfberg discloses providing timely proactive transaction advice to the client (Col. 24, ll. 43-52). Also, Clark do not explicitly disclose enabling a financial advisor user therewith to provide timely proactive transaction advice to the client user. However, Earle discloses the enabling of a user therewith to provide timely proactive transaction advice to the client user (Col. 7, ll. 48-59; Col. 9, ll. 54-57). It would have been obvious at the time of Applicant's invention to have combined the disclosures of Clark with those of Wolfberg and Earle for the purpose of a financial advisory system and workstation that supports the focusing of

Art Unit: 3628

individuals on the financial decisions they must make today, recommends one or more specific financial products given these decisions, protects them from mistakes and, perhaps most importantly, provides an opportunity for their financial decisions to meet their investment goals for the future. The motivation for the practitioner at the time of Applicant's invention to invent such a system would have been motivated by the desire to provide a vehicle by which financial transactions can be made in a timely, reliable and synchronous basis (Earle, Col. 4, ll. 11-14).

3. Claim 2 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Maggioncalda, Wolfberg and Earle as applied to claim 1 above, and further in view of Petruzzi (US Patent 5,806,049) and Fox (US Patent 5,132,899).

Re. Claim 2, Clark discloses an integrated system as recited by claim 1, wherein the plurality of finance-related software applications further comprise at least one finance related software application selected from the group consisting of (Col. 3, lines 17-23):

- a real-time market data application (Col. 10, line 49; Col. 11, line 18);
- a client information application (Clark, Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15);
- an office productivity application (Fig. 15).

However, Clark does not explicitly disclose:

- a financial planning application;
- a calculator application;
- an investment products application;
- an opportunities application opportunities application; and
- an investment research application.

Maggioncalda discloses:

- a financial planning application (Col. 2, line 33 – Col. 3, line 63; Col. 5, lines 32-33);
- a calculator application (Col. 1, lines 31-48; Col. 8, lines 24);
- an investment products application (abstract; Col. 2, lines 12-30, 54-65).

Art Unit: 3628

Also, Petruzzi discloses an opportunities application (Title); and

Fox discloses an investment research application (Fox Col. 5, lines 45-53; many available, among best known available on line is Value Line).

It would have been obvious at the time of Applicant's invention to have combined the disclosures of Clark with those of Maggioncalda, Petruzzi and Fox for the purpose of a financial advisory system that focuses individuals on the financial decisions they must make today, recommends one or more specific financial products given these decisions, and, perhaps most importantly, illustrates the chance that their financial decisions combined with the recommended financial products will meet their needs in the future (Maggioncalda, Col. 1, ll. 54-55).

4. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Wolfberg and Earle as applied to claim 12 above, and further in view of Maggioncalda, Petruzzi and Fox.

Re. Claim 13, Clark discloses a workstation as recited by claim 12, wherein the financial-related software application comprises at least one finance-related software application selected from the group consisting of (Col. 3, lines 17-23):

- a real-time market data application (Col. 10, line 49; Col. 11, line 18);
- a client information application (Clark, Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15); and
- an office productivity application (Fig. 15).

However, Clark does not explicitly disclose

- a financial planning application;
- a calculator application;
- an investment products application;
- an opportunities application; and
- an investment research application.

Maggioncalda discloses a workstation as recited by claim 12, wherein the finance-related software applications are selected from the group comprising:

Art Unit: 3628

- a financial planning application (Col. 2, line 33 – Col.3, line 63, Col. 5, lines 32-33);
- a calculator application (Col. 1, lines 31-48; Col. 8, line 24); and
- an investment products application (Abstract; Col. 2, lines 12-30, 54-65).

Petruzzi discloses an opportunities application (Title); and

Fox discloses an investment research application (Col. 5, lines 45-53).

It would have been obvious at the time of Applicant's invention to have combined the disclosures of Clark with those of Maggioncalda for the purpose of a financial advisory system that focuses individuals on the financial decisions they must make today, recommends one or more specific financial products given these decisions, and, perhaps most importantly, illustrates the chance that their financial decisions combined with the recommended financial products will meet their needs in the future (Maggioncalda, Col. 1, ll. 54-55).

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark, in view of Earle.

Re. Claim 14, Clark discloses an authentication system for creating an application interface of a financial assistance system, the authentication system comprising:

- means for allowing access to a plurality of finance-related software applications permitted by a user entitlement level, the plurality of finance-related software applications comprising, a real-time market data application and a financial planning application (Abstract – ll. 12-14; Col. 2, lines 48-50; Col. 5, line 63 – Col. 6, line 16; Col. 6, lines 36-47);
- means for providing user preferences that allow user to customize the application interface (Col. 2, ll. 36-58; Col. 3, ll. 17-34);
- a system for controlling the access to applications and the user preferences (Col. 25, line 64 – Col. 26, line 24); and
- a real time investor monitoring system for monitoring investor mediated transactions conducted by an investor on an online transaction system and

communicating a communication regarding at least one investor-mediated transaction on a real-time basis upon detecting the at least one investor mediated transaction (Real time - Col. 10, line 49; Col. 11, ll. 16-23).

Clark does not explicitly disclose an investor's communication to a financial advisor. However, Earle discloses an investor's communication to a financial advisor (Col. 7, ll. 48-59; Col. 9, ll. 54-57). It would have been obvious to an ordinary practitioner at the time of Applicant's invention to have modified the disclosure of Clark with that of Earle for the purpose of an authenticated financial assistance system which has the capability to have investors communicate with financial advisors for the purpose of providing a vehicle by which financial transactions can be made in a timely, reliable and synchronous basis (Earle, Col. 4, ll. 11-14).

6. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Maggioncalda.

Re. Claim 15, Clark discloses a system for providing financial information to end users in a workstation and a host computer comprising:

- an application interface having:
 - means for selectively running finance-related software applications simultaneously (Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15); and
 - means for controlling the display of the finance-related software applications, the plurality of finance-related software applications comprising a real-time market data application (Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15); and

an authentication system having:

- means for determining a set of finance-related software applications that a user is entitled to selectively run and display (Fig. 15; Abstract; Col. 2, lines 48-50; Col. 5, line 63 – Col. 6, line 16; Col. 6, lines 36-47); and
- means for setting user preferences that allow a user to customize the application interface for the user based on a stored user preference profile (Col. 2, ll. 36-58; Col. 3, ll. 7-34; Col. 25, line 64 – Col. 26, line 24).

Art Unit: 3628

Clark do not explicitly disclose the providing of all inclusive financial advice, such as financial planning advice. However, Maggioncalda et al. do disclose the providing of a financial planning application (Col. 2, line 33 – Col. 3, line 63; Col. 5, lines 32-33). It would have been obvious at the time of Applicant's invention to have combined the disclosures of Clark with those of Maggioncalda for the purpose of a financial advisory system that focuses individuals on the financial decisions they must make today, recommends one or more specific financial products given these decisions, and, perhaps most importantly, illustrates the chance that their financial decisions combined with the recommended financial products will meet their needs in the future.

Re. Claim 16, Clark discloses a system as recited by claim 15, further comprising means for executing a controller that maps server names; retrieves entitlement levels; retrieves entitlement data; retrieves a user preference profile; creates a local user directory; activates an application interface with retrieved entitlement data and user preferences; and launches the application interface (Col. 25, line 64 – Col. 26, line 24).

Response to Arguments

7. Applicant's arguments filed May 30, 2006 with respect to claims 1, 12, 14 and 15 have been considered but they are not persuasive.

ARGUMENT A:

“... a key feature of claim 1 that is neither disclosed nor taught by the prior art of record. Specifically, the system of claim 1 comprises, *inter alia*:

- (1) at least one workstation for use by financial advisor for providing financial services to at least one investor, and
- (2) a real-time investor monitoring system for monitoring investor mediated transactions concluded by the investor on the online transaction system. The investor monitoring system monitors an investor's account for at least one investor mediated transaction and communicates to the financial advisor a communication regarding the at least one investor-mediated transaction on a real-time basis upon detecting the at least one

investor-mediated transaction. As a result of this real-time monitoring and communication, the financial advisor is able to (1) proactively intercede in the investor-mediated transaction and to (2) provide timely proactive financial advice to investors.” (p. 7, l. 18 – p. 8, l.).

SUPPORTING ARGUMENTS:

(a) “The key to claim 1 is therefore the availability to the *financial advisor* of the real-time monitoring system that enables real-time communication to the investor.” (p. 8, ll. 7-8).

RESPONSE: As a 35 USC 103(A) obviousness combination rejection, the examiner has presented Col. 2, line 36 – Col. 3, line 34; Fig's 1 & 15; Col. 10, line 49 and Col. 11, lines 16-23 of Clark to specifically demonstrate that Clark discloses Applicant's definition of a “real time” response to a computer network transaction by the user/customer/investor. Clark defines real time just as Applicant presents it, which means the practical real time in which computers respond in Applicant's invention. The combination includes the financial advisor limitation taught or suggested by other analogous art which was or would have been obvious to the ordinary practitioner with which to modify Clark's teachings. Here is the most recent opinion from the Federal Circuit regarding obviousness combinations: *In re Kahn*: “A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kotzab, 217 F.3d 1365, 1370 (Fed. Cir. 2000). However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See Lee, 277 F.3d at 1343-46; Rouffett, 149 F.3d at 1355-59. This requirement is as much rooted in the Administrative Procedure Act, which ensures due process and non-arbitrary decisionmaking, as it is in § 103. See id. at 1344-45.” *In re Kahn*, Slip Op. 04-1616,

page 9 (**Fed. Cir. Mar. 22, 2006**). In this case, the examiner has satisfied these guidelines, as will be evident based on the examiner's responses to the additional subsidiary arguments made by Applicant as listed and responded to below.

(b) "Applicants respectfully submit that real-time confirmation back to the customer provides no indication of a **real-time investor monitoring system** that communicates to the financial advisor a communication regarding the at least one investor-mediated transaction **on a real-time basis**. This is what claim 1 recites. Clark does not teach or suggest this feature. Moreover, Clark's simple confirmation does not correspond to a financial advisor's advice. Whether or not this message back to the customer is achieved in real time, as alluded to at Col. 11, lines 16-23, is irrelevant. It is simply not what claim 1 recites." (p. 8, l. – p. 9, l. 3).

RESPONSE: Applicant has **bolded** a limited portion of the above sub-argument. This indicates to the examiner that this particular sub-argument concerns itself with the bolded phrases. As such, per response (a) above, Clark does indeed teach Applicant's version of real time response to a user's transaction, and a real time monitoring system which operates "24 hours a day, 365 days per year" (Col. 2, ll. 42-43). It is not possible to get more real time than that. Clark also teaches or suggests a monitoring system which operates and responds in real-time to the customer who can be served in a wide variety of financial transactions, such as investment activities (Col. 3, ll. 24-25. Securities are investment activities). Col. 10, lines 43-52 disclose "to provide instant feedback immediately (i.e. real time) that the transaction has been accepted and acted upon". As is evident in the above rejection of claim 1, and as acknowledged in Applicant's arguments, the examiner has not claimed that Clark explicitly teaches or suggests a human financial advisor. The examiner has relied on Earl to teach or suggest a human financial advisor (see response to the argument against the Earl reference below). It should be noted that if Clark did teach this and some other limitations the examiner has not attributed to Clark these might have been anticipation rejections.

(c) Regarding Wolfberg, "...Applicants submit that the mere provision of a balance check does not teach or suggest financial advice from financial advisor, as required by claim 1." (p. 10, ll. 4-6).

RESPONSE: The examiner has not attributed this teaching or suggestion to Wolfberg. In laying out the obviousness combination case under the *In Re Kahn* (see above) guidelines, the examiner's rejection merely relies on Wolfberg for "providing timely proactive transaction advice to the client (Col. 24, ll. 43-52)".

(d) "...the cited sections of Earle do not support the argument of the Office Action. For example, the cited portion of Col. 7 refers to the Investment Advisors" 118 and Custodians" 116. However, as shown in Fig. 1A, the Investment Advisors 118 and Custodians 116 are not individuals. Rather, the Custodians 116 are banks (see col. 7, lines 53-56). The Applicants could find no specific definition of the Investment Advisors 118, but these elements appear to be hardware/software system elements associated with a Fund Accountant 120 that is responsible for maintaining the mutual fund portfolio records. The Fund Accountant 120 communicates with Investment Advisors 118 and each Investment Advisor 118 has a banking relationship with a Custodian Bank (see col. 7, lines 38-59; Fig. 1A). However, Applicants have found no teaching or suggestion of the specific real-time communication between an on-line investor and a financial advisor, as recited in claim 1." (p. 10, ll. 14-24).

RESPONSE: Earle does indeed suggest human Investment Advisors in Earle's disclosure in Col. 7, l. 48 – Col. 8, l. 2. This becomes clear in the sentence in Col. 7, l. 67 – Col. 8, l. 1, which states "Redemptions redeem shares for cash or in kind with eligible securities approved and values by the Investment Advisor". The ordinary practitioner of the art would have taken this as a suggestion of human advisors, not computer systems, since no evidence exists in Earle to suggest that this activity is an automated computer system activity, as he has so painstakingly done in regard to various actual computer systems he does teach.

(e) "... the Applicants respectfully submit that the Examiner has used claim I as a

Art Unit: 3628

template for picking and choosing variously loosely worded phrases from many different, unrelated patents in an attempt to find isolated comments to allegedly suggest specific recitations taken out of the context of claim 1 as a whole. The Applicants submits that this represents impermissible hindsight." (p. 11, ll. 4-7).

RESPONSE: The motivation cited by the examiner, namely to "achieve superior investment performance" is indeed what ordinary investors primarily keep striving for. Using a belittling argument without substantive reasoning to invalidate the examiner's motivation statement for the ordinary practitioner at the time of Applicant's invention fails meet Applicant's rebuttal obligation per the MPEP (The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a *prima facie* case of obviousness."). See MPEP § 716.01(c)).

"[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on inherency' under 35 U.S.C. 102, on *prima facie* obviousness' under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same...[footnote omitted]." The burden of proof is similar to that required with respect to product-by-process claims. *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977))." (MPEP § 2112.01).

(f) '... has not demonstrated that there was any reason to combine the cited references, The cited "motivation" is so vague and general as to simply be a piece of puffery extolling the hoped-for results of any investment management system, i.e., to "achieve superior investment performance." Applicants respectfully submit that this generality cannot constitute a motivation to combine any specific teachings of any specific references.' (p. 11, ll. 8-14).

RESPONSE:

(1) *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). ¶ Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within level of ordinary skill at time

claimed invention was made and **does not include knowledge gleaned only from applicant's disclosure**, reconstruction is proper. This opinion is consistent with the recent *In Re Kahn* opinion of the Federal Circuit Court. Accordingly, the examiner's does not invoke impermissible hindsight reasoning.

SUMMARY OF RESPONSE TO ARGUMENT A:

The key feature of claim 1 argued above as missing would have indeed been seen by the ordinary practitioner of the art at the time of Applicant's invention as disclosed, taught, suggested or obvious from the prior art of record or from the practitioner's own knowledge, or a combination thereof, according to the standards of the recently issued Federal Circuit opinion in *In Re Kahn*..

ARGUMENT B:

Regarding claim 15, 'Applicants have found no teaching or suggestion, in these portions or in Clark or the Other references generally, that an authentication system determines which programs a user is entitled to selectively run and display. In response, the present Office Action (see page 12) argues that Clark "does entitle a customer to selectively run and display programs available on the financial institution's online system." However, this is not what Claim 15 recites. The issue is not whether the customer can run programs on the system; the issue is whether Clark, or any of the other references, teach or suggest "an authentication system determines *which* programs a user is *entitled* to selectively run and display.' (p. 12, ll.).

RESPONSE: Applicant's claimed limitations are "means for" claims. The emphasis is on the "means", while the claimed purposes reside in the method claims. Under the obviousness combination standard of *In Re Kahn*, the examiner has correctly demonstrated that Clark and Maggioncalda would have reasonably led an ordinary practitioner of the art at the time of Applicant's invention to use the appropriate means for operating the claimed method features.

Conclusion

Art Unit: 3628

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Hyung S. Souh, can be reached on (571) 272-6799.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks, Washington D.C. 20231

or faxed to:


(571) 273-8300 [Official communications; including After Final communications labeled "Box AF"]

(571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

June 22, 2006


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